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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 4162 Doerr Road, Inc.
d/b/a Marshall Distributing, Inc.

Serial No. 75/582,753

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McCulloch, PLLC for 4162 Doerr Road, Inc. d/b/a Marshall
Distributing, Inc.

Cimmerian Coleman, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 4, 1998, 4162 Doerr Road, Inc. d/b/a
Marshall Distributing, Inc. (applicant) filed an
application to register the mark HI-TORQUE (in typed form)
on the Principal Register for goods ultimately identified
as "land vehicle parts, namely, snowmobile drive belts" in
International Class 12. The application contains a date of

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first use and a date of first use in commerce of November 1, 1991.

The Examining Attorney has refused to register applicant's mark on two grounds. First, the Examining Attorney held that applicant's mark is not registrable under the provisions of Section 2(d) of the Trademark Act because of a registration for the following mark for "starter motors for land vehicles" in International Class 7.¹ 15 U.S.C. § 1052(d).



The Examining Attorney determined that there would be a likelihood of confusion when the marks HI-TORQUE and HI-TORQUE and design are used on the identified goods. The Examining Attorney also refused to register applicant's mark under the provisions of Section 2(e)(1) of the Trademark Act because the Examining Attorney found that the term was merely descriptive of applicant's goods. 15 U.S.C. § 1052(e)(1).

¹ Registration No. 1,858,370 issued on October 18, 1994. A Section 8 affidavit has been accepted.

After the Examining Attorney made the refusals to register final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was held on February 6, 2002.

Regarding the refusal under Section 2(d), the Examining Attorney's position is that the marks are nearly the same and the "only difference between the marks is the stylization in the registrant's mark in which a lightning bolt forms the letter 'T' in "TORQUE.'" Examining Attorney's Br. at 4. According to the Examining Attorney, this difference between the marks does not obviate the similarity between the marks. The Examining Attorney also determined that both applicant's and registrant's goods are used on land vehicles. Registrant's "starter motors for land vehicles" could include starter motors for snowmobiles. The Examining Attorney included several third-party registrations that suggested that the source of various motors would also be the source of drive belts. The Examining Attorney concluded that applicant's and registrant's goods "are likely to be marketed in the same manner and purchased through common trade channels," and thus, when similar marks are used on these goods, there is a likelihood of confusion. Examining Attorney's Br. at 10.

The Examining Attorney also refused to register applicant's mark on the ground that the term "hi torque" is merely descriptive as applied to drive belts because it is "a type of drive belt." Examining Attorney's Br. at 11. The Examining Attorney submitted evidence that "high" is defined as "of great force" and "torque" refers to "turning or twisting force."² In addition, the Examining Attorney included printouts of stories retrieved from an electronic database to show the descriptive nature of the term HI TORQUE.

Poly Chain is a registered tradename for synchronous, **high-torque** drive belts.
Industrial Maintenance & Plant Operations, March 31, 1999.

A 9-ram **high torque** drive belt drives a leadscrew in the elevation can mechanism.
Plastic Engineering, May, 1995.

A recent addition to the flexible belt family is the HTD (**high torque** drive) belt. HTD belts, also known as second-generation synchronous belts, are toothed and require installation of mating toothed-drive sprockets.
Energy User News, March, 1995.

The maker drives are instead transmitted through **high torque** drive belts to separate gear boxes.
Tobacco International, May 1, 1991.

High torque drive belts are available for applications that require greater load carrying capability.
Automation, January, 1991.

² *American Heritage Dictionary of the English Language, Third Edition* (1992).

Turning to the transmission, he said whereas previous machines had used a lot of shafts and gears, these had been replaced in the Passim 7000 with **high torque** drives and belts, and this had contributed to a significant reduction in noise.
World Tobacco, November, 1990.

Another important benefit of **high torque** drive belts is maintenance-free operations.
American Metal Market, October 15, 1984.

The Examining Attorney relies on this evidence to show that high torque drive belts are a type of belt, and the term, therefore, would describe a significant attribute of applicant's goods.

Applicant responds to the likelihood of confusion refusal by pointing out that the cited registration has the "T" in "torque" in the form of a lightning bolt and that the differences in the marks outweigh their similarities. Regarding the goods, applicant maintains that drive belts for snowmobiles and starter motors for land vehicles are so widely different that they are classified in two different international classes. In addition, applicant argues that "even if it is assumed that a dealer sells both starter motors and drive belts, as suggested by the examining attorney, it is unlikely that a prospective purchaser would assume that the manufacturer of the starter motor is the same as or has a relationship with the manufacturer of the drive belt." Applicant's Br. at 7.

Applicant also refers to two other registrations. One is for the mark HYTORQ and design (No. 1,717,507) for "oil hydraulic vane pumps and parts therefor, oil hydraulic gear pumps and parts therefor, worm gear reducers, gear speed reducers, winches and hoists." The other (No. 2,007,693) is for HY TORQ for "marine propellers for commercial and pleasure boats."³ Applicant states that "[i]t is not believed that any one seeing a snowmobile drive belt would be any more likely to assume that such belt emanates from the manufacturer of starter motors, and vice versa, than one would assume that starter motors, small engines, and pumps emanate from the same source." Applicant's Br. at 9.

As to the descriptiveness refusal, applicant maintains that:

A drive belt may, and indeed does, enable the transmission of torque from one component to another, but to arrive at this characteristic of the drive belt one must perform a mental exercise that associates the drive belt not only with the drive generating means, but also with the object to which the drive generating means is coupled by the drive belt.

Applicant's Br. at 15-16.

³ Applicant also refers to a third registration, HIGH TORQUE (No. 1,091,591) for "mowers and small internal combustion engines" on the Supplemental Register. This registration expired on February 22, 1999.

Applicant concludes by arguing that if its mark "is deemed to be descriptive, it is not merely descriptive." Applicant's Br. at 16.⁴

Inasmuch as we agree with the Examining Attorney that there is a likelihood of confusion and that the mark is merely descriptive, we affirm the Examining Attorney's refusals to register.

I. Likelihood of Confusion

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to the similarity of the marks. The question here is whether the marks create the same commercial impression. The test is not whether the marks

⁴ Applicant's offer in its Appeal Brief to seek registration under the provision of Section 2(f) of the Trademark Act is untimely. 37 CFR § 2.142(d) (Record should be complete prior to appeal). Applicant did not request a remand to the Examining Attorney. TBMP § 1207.02.

can be distinguished in a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, the marks are for the identical term "HI TORQUE." While applicant argues that there are differences between the marks, they consist only of the presence of a hyphen in applicant's mark, a design of lightning bolt for the letter "T" in registrant's mark, and the stylized lettering of registrant's words. The presence or absence of a hyphen does not change the pronunciation of the marks and the slight change in the appearance of the marks does not change the marks' meanings or commercial impressions. Applicant admits that the lightning bolt design "is suggestive of electrical characteristics such as normally associated with starter motors." Applicant's Br. at 5. When the marks are considered in their entireties, we cannot agree with applicant that the differences outweigh

their similarities. The design element in registrant's mark, which is suggestive of the goods, would not overcome the fact that both marks contain the same words, and applicant's mark is devoid of any design element.

Potential purchasers are likely to use the words in the registration when they refer to the goods. Registrant's design does not serve to eliminate the likelihood of confusion. See In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion). See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S and design for grocery and general merchandise store services found likely to be confused with BIGGS and different design for furniture); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Second, we must consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the

issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). The goods in this case are "land vehicle parts, namely, snowmobile drive belts" and "starter motors for land vehicles." From the identification of goods, it is clear that both registrant's and applicant's goods are parts for land vehicles. We also note that registrant's goods are defined simply as "starter motors for land vehicles" so we must assume that these starter motors include starter motors for snowmobiles.⁵ The Examining Attorney has included evidence to show that drive belts and various motors are sold under the same mark (Registration Nos. 2,045,412; 2,093,982; 1,776,262; and 1,780,162). See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a

⁵ Contrary to applicant's argument, the fact that registrant's and applicant's goods are classified in different classes is not relevant. National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1216 n.5 (TTAB 1990) ("The classification system was established for the convenience of the Office rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related").

single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Thus, applicant's and registrant's identified goods would both include parts for snowmobiles. Purchasers of starter motors and drive belts for snowmobiles would include the same people who were interested in repairing or servicing snowmobiles. The Board has previously recognized that in similar situations confusion would be likely.

Mufflers and automotive motors, although different, nevertheless comprise automotive parts and accessories which, as argued by the examiner, could be purchased through the same trade channels including dealers, service stations, automotive accessories and supply stores and outlets by the same classes of purchasers such as repairmen, dealers and motorists.

In re Magic Muffler Service, Inc., 184 USPQ 125, 126 (TTAB 1974). See also In re Delbar Products, Inc., 217 USPQ 859, 861 (TTAB 1981) ("While it is clear that applicant's vehicle mirrors and registrant's automobile parts are specifically different products, nevertheless they both comprise automotive parts and accessories which could be purchased through the same channels of trade").⁶

⁶ We are aware of the case of Hi-Shear Corp. v. National Automotive Parts Association, 152 USPQ 341, 344 (TTAB 1966), in which the Board held that the mark N.A.P.A. HI-TORQUE, "hi torque" disclaimed, for power tools was not confusingly similar to the mark HI-TORQUE on the Supplemental Register for screws and bolts. The presence of applicant's house mark, the differences in the goods, and the admitted descriptiveness of the term "hi-torque" by both parties are all factors that are not present in this case.

We cannot agree with applicant's argument that "it is unlikely that a prospective purchaser would assume that the manufacturer of the starter motor is the same as or has a relationship with the manufacturer of the drive belt." Applicant's Br. at 7. As with automobile parts, it is likely that starter motors and drive belts for snowmobiles when sold under very similar marks would lead prospective purchasers to believe that there is a single source of the goods.

Applicant argues that there are two registrations for the term "high torque" for marine propellers and hydraulic vane pumps, and this fact supports the registration of applicant's mark. However, these goods are less related because registrant's goods include parts for snowmobiles while the third-party registrations do not. Even if the goods in the third-party registrations were considered to be closely related to applicant's goods, it is not clear how this fact would justify the registration of another confusingly similar registration.

Applicant argues that there has been no actual confusion in this case. It is unnecessary, however, to show actual confusion in establishing likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J

Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Moreover, an ex parte proceeding provides no opportunity for the registrant to show instances of actual confusion. Thus, the applicant's assertion of a lack of evidence of actual confusion does not significantly demonstrate that there is no likelihood of confusion in this case.

Applicant also discusses the remaining du Pont factors and concludes that there is no likelihood of confusion. We can agree with applicant that several of the factors would favor applicant and that there is no evidence on other factors. However, when we balance the fact that the marks are for the identical words and the goods include parts for snowmobiles, we conclude that there is a likelihood of confusion.

Finally, applicant requests that we resolve doubts in favor of publishing its mark for opposition. This request is contrary to long established case law.

If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant. The rule is usually applied in inter partes cases but it applies equally to ex parte rejections.

In re Pneumatiques, Caoutchouc Manufacture et
Platitudes Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729

(CCPA 1973). See also Dixie Restaurants, 41 USPQ2d at 1535 ("Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks"). Therefore, we decline to follow applicant's suggestion.

II. Descriptiveness

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218. Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 807, 120 USPQ 293, 294 (CCPA 1959).

While applicant argues that "a drive belt does not, itself, possess the property of torque, either high or low," (Applicant's Br. at 15) the Examining Attorney has included evidence to show that the term "high torque" is commonly used to describe a type of drive belt.⁷ The Examining Attorney's evidence does show that drive belts in various industries are described as "high torque." There is nothing incongruous about applying the term "high torque" to a drive belt. We also note that, while it is not conclusive evidence, applicant's specimens appear to use the term in a descriptive manner in the phrase "Ultimate Hi-Torque Performance." Similarly, the Board has previously held that the term HI-TORQUE "can be used to describe any product which is designed to withstand or develop a high torque action." Hi-Shear Corp., 152 USPQ at 343. See also In re Chicago Pneumatic Tool Co., 160 USPQ 628 (TTAB 1968) (EVEN-TORK is merely descriptive of a clutch that is a component of a power-operated screwdriver). Applicant's term "hi-torque" would thus be merely descriptive of drive belts used in, or designed to withstand, high torque action.

⁷ The slight misspelling of the word "high" does not change the descriptive nature of the mark. Hi-Shear Corp., 152 USPQ at 343 (HI-TORQUE "is the phonetic equivalent of the words 'HIGH TORQUE'").

Applicant argues that the suggestive nature of its mark is supported by three registrations. First, "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." Nett Designs, 57 USPQ2d at 1566. Second, the three registrations to which applicant refers are for different goods, and two of these registrations have design elements. The fact that these registrations have issued hardly compels a conclusion that applicant's mark is not descriptive. We do not have the record of those cases but in this case there is significant evidence of the common use of the term "hi torque" to describe drive belts.

Decision: The refusals to register the mark are affirmed.